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10/766,039	01/29/2004	Hiroyuki Hatta	1538.1045	2575

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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/766,039	HATTA ET AL.	
	Examiner	Art Unit	
	Wilson Lee	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 March 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continued Examination Under 37 CFR. 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued under 37 CFR 1.114, and fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/27/08 has been entered.

Response to Arguments

Applicant's arguments filed on 3/27/08 have been fully considered but they are not persuasive.

Argument #1

Applicant argues that Whitman fails to disclose extracting data of documents from a storage corresponding to the display item selected by user.

Response #1

Examiner is not persuaded.

The data in the database must be read out at least to the RAM in order to be searched. All the data in all databases are presented in binary code. When a user searches for the information within the database, the binary code must be read out from the database and converted into readable characters by processor and appropriate software. Such act of "reading out" has equivalent meaning of "extracting" or "pulling out".

Argument #2

Applicant argues that Whitman fails to disclose transforming the data of document into information in indicate the data of document to user.

Response #2

Examiner is not persuaded.

As explained above, the data is presented in binary code within the database. The data is inherently transformed into hyper link and readable text displayed on the screen to indicate the document to user.

Argument #3

Applicant argues that Whitman fails to disclose receiving designation of a second display form from the user.

Response #3

Examiner is not persuaded.

User can click or choose other Search method such as ISBN, Publisher/Date, Quick Search as the refinement search (fig. 2). When user clicks on these hyper links, the system receives the command of user or designation of the second display such as other querying inputs for ISBN, Publisher/Date, Quick Search. It would be a different display form than the Author and Subject Search.

Argument #4

Applicant argues that Whitman fails to disclose the related searches included in the plurality of documents.

Response #4

Examiner is not persuaded.

As shown in fig. 8, under "Related Searches", "Top Matches for this search", and "Full Results", the phases such as *To say nothing of the dog, Don't shoot the dog: The New Art of Teaching & Training,* .etc. are the keywords and terms (data) of the books (documents) that are matched with the input queries.

Argument #5

Applicant argues that Whitman fails to disclose generating information to display the extract data items and segment that connects between the data items.

Response #5

Examiner is not persuaded.

Applicant alleges that according to the cited portions of Whitman, a predetermined number of related search phrases are sorted and presented to the user for selection. But the citation does not explain why Whitman does not obtain segment. While the results can be sorted and presented to user for selection, the search key term and document must be linked in order to show the item.

Claim Rejections – 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18, 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract

(i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter.

According to specification, all of elements, e.g. search unit, transformers, extractor, receiver of the apparatus defined by claim 18 are software components. It is merely functional descriptive material and is nonstatutory. It fails to fit within any patentable categories: process, machine, manufacture or composition of matter.

Claim Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12, 14, 16-20, 21, 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Whitman et al. (6,772,150).

Regarding Claim 1, Whitman discloses a computer-implemented search processing method, comprising:

- searching a predetermined document group according to a first search condition specified by a user to extract data of a plurality of documents from a storage (133) that stores said predetermined document group (Fig. 8 and Col. 1, lines 15-44, Col. 6, lines 1-15, Col. 6, lines 58-68; Col. 7, lines 1-12 and Col. 14, lines 13-22);

- transforming said data of said plurality of documents into information to indicate said data of said plurality of documents to said user in a first display form and to enable said user to select a display item to be utilized as a second search condition (refining the query, Col. 1, lines 53-62 and Col. 3, lines 39-55) in a following processing, wherein said display item is generated from said data of said plurality of documents extracted fomr said storage (see response #1) and outputting the transformed information (810, 820) (Fig. 8 and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22);
- receiving designation of a second display form from the user (see response #3);
- extracting data of documents corresponding to said display item selected by said user from the storage (133) or the data of the plurality of documents (Abstract and Col. 2, lines 25-40 and Col. 3, lines 39-57, Col. 4, lines 1-7 and Col. 5, lines 44-64, Col. 6, lines 1-15); and
- transforming said data of said documents corresponding to said selected display item into information to indicate said data of said documents to said user in a second display form (refining the query, Col. 1, lines 53-62 and Col. 3, lines 39-55), which is designated by said user and different from the first display from (See response #3), specified by said user and to enable said user to select a display item to be utilized as a third search condition in a following processing ("refining" can be more than two),

wherein said display item is generated from said data of said documents corresponding to the selected display item (See responses #1, 2) and outputting the transformed information (Fig. 8, and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22).

Regarding Claim 2, Whitman discloses that a first form showing indications of extracted documents (recent set of query) that have been classified by used words (search phrases previously-submitted) in said extracted documents (Col. 2, lines 13-40)

Regarding Claim 3, Whitman discloses that the first transforming comprises:

- dividing said plurality of documents into clusters (Related Searches, Top Matches, Full Results) by using said data of said plurality of documents (fig. 8);
- extracting second data to be displayed from said data of said plurality of documents, wherein a type of the extracted second data is predefined for said first display form (Abstract and Col. 2, lines 25-40 and Col. 3, lines 39-57, and Col. 4, lines 1-7 and Col. 5, lines 44-64); and
- generating, for each said cluster, information to display the extracted second data to be utilized as said second search condition in said following processing (Fig. 8 and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22).

Regarding Claim 4, Whitman discloses that the first transforming comprises:

- calculating (selection process) a degree of relevancy (relevant item) between said plurality of documents by using said data of said plurality of documents (Col. 1, lines 15-24; Col. 7, lines 26-44);
- extracting, for each of said plurality of documents a data item to be displayed from said data of said plurality of documents, wherein a type of said data item is predefined for said first display form (Abstract and Col. 2, lines 25-40 and Col. 3, lines 39-57 lines 1-7 and Col. 5, lines 44-64); and
- generating information to display the extracted data items to be utilized as said second search condition in said following processing in said following processing, and a segment that connects between said data items (search key term and document must be linked in order to display the item) and represents the calculated degree of relevancy between said documents corresponding to said data items (Fig. 8, and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22).

Regarding Claim 5, Whitman discloses dividing said plurality of documents into classes (Related Searches, Top Matches, Full Results) based on used words included in said data of said plurality of documents (fig. 8), and counting a number of documents in each said class based on a specific matter predefined for said first display form (figs. 1, 8); and generating information to display the counting result (figs. 1, 8).

Regarding Claim 6, Whitman discloses that the first transforming comprises:

- calculating (selection process) a degree of relevancy (relevant item) between used words included in said data of said plurality of documents (Col. 1, lines 15-24; Col. 7, lines 26-44); and
- generating information to display said used words to be utilized as said second search condition in said following processing, and a segment that connects between said used words (search key term and document must be linked in order to display the item) and represents the calculated degree of relevancy between said used words (Fig. 8 and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22).

Regarding Claim 7, Whitman discloses first transforming comprises:

- relating said plurality of documents into document groups (Related Searches, Top Matches, Full Results) based on a specific matter predefined for said first display form (fig. 8);
- calculating (selection process) a degree of relevancy between said document group and a used word included in said data of said plurality of documents (Col. 1, lines 15-24; Col. 7, lines 26-44); and
- generating information to display said document groups by said data of said specific matter, and the calculated degree of relevancy (relevant item) between said document group and said used word by a segment connecting between said document group and said used word (search key term and document must be linked in order to display the item),

wherein said document group and said used word are to be utilized as said second search condition in said following processing (figs. 1, 2, 8).

Regarding Claim 8, Whitman discloses that the second transforming comprises:

- dividing said documents corresponding to said selected display item into clusters (Related Searches, Top Matches, Full Results) by using said data of said documents corresponding to said selected display item (fig. 8);
- extracting third data to be displayed from said data of said documents corresponding to said selected display item, wherein a type of the extracted third data is predefined for said second display form (Abstract and Col. 2, lines 25-40 and Col. 3, lines 39-57 lines 1-7 and Col. 5, lines 44-64); and
- generating, for each said cluster (Related Searches, Top Matches, Full Results, information to display the extracted third data to be utilized as said third search condition (refining search can be more than two) in said following processing (figs. 1, 2, 8).

Regarding Claim 9, Whitman discloses second transforming comprises:

- calculating (selection process) a degree of relevancy between said documents corresponding to said selected display item by using said data of said documents corresponding to said selected display item (Col. 1, lines 15-24; Col. 7, lines 26-44);

- extracting, for each said documents corresponding to said selected display item, a data item (810, 820) to be displayed (fig. 8) from said data of said documents corresponding to said selected display item wherein a type of the second data item is predefined for the second display form (refining the query, Col. 1, lines 53-62 and Col. 3, lines 39-55) (Abstract and Col. 2, lines 25-40 and Col. 3, lines 39-57 and Col. 4, lines 1-7 and Col. 5, lines 44-64); and
- generating information to display the extracted second data (refined) items to be utilized as said third search condition in said following processing (refining search), and a segment that connects between said second data items (search key term and document must be linked in order to display the item) and represents the calculated degree of relevancy between said documents corresponding to said selected second data (figs. 1, 2, 8 and Col. 6, lines 1-28).

Regarding Claim 10, Whitman discloses that second transforming comprises:

- dividing said documents corresponding to said selected display item into classes (Related Searches, Top Matches, Full Results) based on used words included in said data of said documents corresponding to said selected display item (fig. 8), and
- counting a number of documents in each said class based on a specific matter predefined for said second display form (figs. 1, 2, 8); and generating information to display the counting result (figs. 1, 2, 8).

Regarding Claim 11, Whitman discloses that said second transforming comprises:

- calculating a degree of relevancy between used words included in said data of said documents corresponding to said selected display item (Col. 1, lines 15-24; Col. 7, lines 26-44); and
- generating information to display said used words to be utilized as said third search condition (refining search can be more than two) of said following processing (Fig. 8 and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22), and a segment (search key term and document must be linked in order to display the item) that connects between said used words and represents the calculated degree of relevancy between said used words (figs. 1, 2, 8).

Regarding Claim 12, Whitman discloses that said second transforming comprises:

- categorizing said documents corresponding to said selected display item into document groups (Related Searches, Top Matches, Full Results) based on a specific matter predefined for said second display form (fig. 8);
- calculating (selection process) a degree of relevancy between said document group and a used word included in said data of said documents corresponding to said selected display item (Col. 1, lines 15-24; Col. 6, lines 16-29 and Col. 7, lines 26-44); and

- generating information to display said document groups by said data of said specific matter (810 in Fig. 8 and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22), and the calculated degree of relevancy (relevant item) between said document group and said used word by a segment (search key term and document must be linked in order to display the item) connecting between said document group and said used word, said document group and said word are to be utilized as said third search (refining search can be more than one) condition in said following processing (figs. 1, 2, 8).

Regarding Claim 14, Whitman discloses at least either of said first and second transforming comprises specifying a display program corresponding to a display form, and generating information for said display program (figs. 1, 2, 8).

Regarding Claim 16, Whitman discloses a computer readable medium storing instructions being executable by a processor to perform a method comprising:

- searching a predetermined document group according to a first search condition specified by a user to extract data of a plurality of documents from a storage that stores said predetermined document group (Fig. 8 and Col. 1, lines 15-44, Col. 6, lines 1-15, Col. 6, lines 58-68; Col. 7, lines 1-12 and Col. 14, lines 13-22);
- transforming said data of said plurality of documents into information to indicate said data of said plurality of documents to said user in a first display form and to enable said user to select a display item to be utilized

as second search condition in a following processing (refining the query, Col. 1, lines 53-62 and Col. 3, lines 39-55), wherein said display item is generated from said data of the plurality of documents extracted from said storage (See responses #1, 2) and outputting the transformed information (810, 820) (Fig. 8 and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22);

- receiving designation of a second display form from said user (response #3);
- extracting data of documents corresponding to said display item selected by said user from the storage (133) or the data of the plurality of documents (Abstract and Col. 2, lines 25-40 and Col. 3, lines 39-57 and Col. 4, lines 1-7 and Col. 5, lines 44-64, Col. 6, lines 1-15); and
- transforming said data of said documents corresponding to said selected display item into information to indicate said data of said documents to said user in a second display form, which is designated by said user and different from the first display from (See response #3), specified by said user (refining the query, Col. 1, lines 53-62 and Col. 3, lines 39-55) and to enable said user to select a display item to be utilized as a third search condition in a following processing ("refining" can be more than two), wherein said display item is generated from said data of said documents corresponding to said selected display item (responses #1, 2) and

outputting the transformed information (810) (Fig. 8, and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22).

Regarding Claim 17, Whitman discloses that a first form showing indications of extracted documents (recent set of query) that have been classified by used words (search phrases previously-submitted) in said extracted documents (Col. 2, lines 13-40).

Regarding Claim 18, Whitman discloses a search processing apparatus, comprising:

- a search unit that searches a predetermined document group according to a first search condition specified by a user to extract data of a plurality of documents from a storage (133) that stores the predetermined document group (Fig. 8 and Col. 1, lines 15-44, Col. 6, lines 1-15, Col. 6, lines 58-68; Col. 7, lines 1-12 and Col. 14, lines 13-22);
- a first transformer that transforms said data of said plurality of documents into information to indicate said data of said plurality of documents to said user in a first display form and to enable said user to select a display item to be utilized as a second search condition a following processing (refining the query, Col. 1, lines 53-62 and Col. 3, lines 39-55) wherein said display item is generated from said data of the plurality of documents extracted from said storage (See responses #1, 2), and outputs the transformed information (810, 820) (Fig. 8 and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22);

- a receiver that receives designation of a second display form from said user (response #3);
- an extractor that extracts data (data extracted and displayed) of documents corresponding to said display item selected by said user from the storage (133) or the data of the plurality of documents (Fig. 8, Col. 6, lines 1-15, and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22); and
- a second transformer (refining the query, Col. 1, lines 53-62 and Col. 3, lines 39-55) that transforms said data of said documents corresponding to said selected display item into information to indicate said data of said documents to said user in a second display form, which is designated by said user and different from the first display from (See response #3), specified by said user and to enable said user to select a display item to be utilized as a third search condition ("refining" can be more than two) in a following processing, wherein said display item is generated from said data of said documents corresponding to said selected display item (responses #1, 2), and outputs the transformed information (Fig. 8 and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22).

Regarding Claim 19, Whitman discloses that a first form showing indications of extracted documents (recent set of query) that have been classified by used words (search phrases previously-submitted) in said extracted documents (Col. 2, lines 13-40).

Regarding Claim 20, Whitman discloses a method, comprising:

- extracting data selected by a user from a plurality of documents stored (stored as temporarily for the refinement search. Col. 1, lines 53-62 and Col. 3, lines 39-55) (And data can be stored in database 133 in Fig. 8) as a predetermined document group by searching the predetermined document group based on a search condition (Fig. 8, Col. 6, lines 1-29, and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22);
- transforming the data from the plurality of documents stored in the predetermined document group into information to the user in a display form, which is designated by the user (response #3) that enables the user to select a search result (select or click on the displayed items, search results in fig. 8) as a following search condition to search the predetermined document group based on the following search condition, the search result is generated from the data stored in the predetermined document group (see responses #1, 2) and outputting a transformed search result. (Fig. 8, Col. 6, ines 1-29, Col. 7, lines 59 to Col. 8, line 5, Col. 14, lines 13-32).

Regarding Claims 21, 22, as discussed above in details in the preceding rejections on claims 1 and 18, Whitman meets the limitations of claims 21, 22.

Claim Rejections – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitman et al. (6,772,150).

Regarding Claim 13, Whitman does not explicitly disclose that a document included in said predetermined document group is a patent document, and said display item is either of bibliographic information of said patent document and a used word in said patent document. However, since books and patents are both text documents. If one can search books on a machine then one can surely search patents which is technically reasonable. There is no technical different between books and patents because they are both in text and image file. It would have been obvious to one of ordinary skill in the art to upload patent documents to the database of the Whitman's search engine to cover the usage in searching patent documents (e.g. bibliography) in order to search the book author's (if the author is also inventor) possible invention.

Regarding Claim 15, although Whitman does not explicitly disclose an arbitrary combination (any combination) of predefined display forms, however, rearranging the location of the results and display the lists in any manner does not provide unexpected and useful result. It would have been obvious to one of ordinary skill in the art to display the result in any desired manner or form in order to attract the user's attention based on a desired group (e.g. if user likes the section of Full Results appears first, it could be placed above the section of Related Searches.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Wilson Lee whose telephone number is (571) 272-1824.

Papers related to the application may be submitted by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "DRAFT". The official fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Wilson Lee/
Primary Examiner, Art Unit 2163

6-23-08